

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Todd A. Schwartz et al. Examiner: Robert E. Rhode, Jr.

Serial No.: 10/027,420 Group Art Unit: 3625

Filed: December 20, 2001 Docket: 884.619US1

For: PRICING OPTIONS FOR DIGITAL CONTENT PRODUCTS

Customer No. 21186

APPEAL BRIEF UNDER 37 CFR § 41.37

Mail Stop Appeal Brief- Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is presented in response to the Decision on Pre-Appeal Brief Request for Review, mailed on May 23, 2006, from the Final Rejection of claims 1-5 and 7-11 of the above-identified application, as set forth in the Final Office Action mailed on February 27, 2006. A Notice of Appeal was filed with the U.S. Patent Office on April 27, 2006, so it is believed that the due date for filing the Appeal Brief is June 27, 2006.

The Commissioner of Patents and Trademarks is hereby authorized to charge Deposit Account No. 19-0743 in the amount of \$500.00 which represents the requisite fee set forth in 37 C.F.R. § 41.2(b)(2). The Appellant respectfully requests consideration and reversal of the Examiner's rejection of the pending claims.

1. REAL PARTY IN INTEREST

The real party in interest of the above-captioned patent Application is the assignee, INTEL CORPORATION.

2. RELATED APPEALS AND INTERFERENCES

There are no other appeals, interferences, or judicial proceedings known to Appellant, Appellant's legal representative, or the Assignee that are related to, will directly affect, be affected by, or have a bearing on the Board's decision in the instant Appeal.

3. STATUS OF THE CLAIMS

The instant Application was filed on December 20, 2001 with claims 1-27. A restriction requirement was mailed to the Appellant on June 24, 2005. Claims 1-5 and 7-11 were selected for examination in the first Office Action mailed on September 29, 2005, responding to the Appellant's election, with traverse, of Claim Grouping I (including at least claims 1-7). Claims 6 and 12-24 were withdrawn from consideration, and claims 1-5 and 7-11 were rejected.

In reply to the Appellant's Office Action Response filed on November 29, 2005, a Final Office Action (hereinafter the "Office Action") was mailed February 27, 2006, also rejecting claims 1-5 and 7-11. A Pre-Appeal Brief conference was held in response to a Pre-Appeal Request for Review filed by the Appellant on April 27, 2006. As a result, claims 1-27 remain pending, claims 1-5 and 7-11 stand twice rejected, and claims 1-5 and 7-11 remain under appeal.

4. STATUS OF AMENDMENTS

No amendments have been made subsequent to the Final Office Action dated February 27, 2006.

5. SUMMARY OF CLAIMED SUBJECT MATTER

This summary is presented in compliance with the requirements of Title 37 C.F.R. § 41.37(c)(1)(v), mandating a “concise explanation of the subject matter defined in each of the independent claims involved in the appeal ...”. Nothing contained in this summary is intended to change the specific language of the claims described, nor is the language of this summary to be construed so as to limit the scope of the claims in any way.

Some embodiments of the invention are related to a digital content pricing apparatus comprising a sales computer to calculate a final price; and a memory capable of being communicatively coupled with the sales computer, including a plurality of digital content items, wherein each one of the plurality of digital content items is associated with a base price and includes at least one item configuration option associated with an option price, and wherein one of the plurality of digital content items is associated with the final price related to the base price and the option price by a final pricing formula. (Application, Independent claim 1; FIG. 1; pg. 3, lines 14 - pg. 7, line 15).

Some embodiments of the invention are related to a digital content pricing system comprising a sales computer to calculate a final price; a purchase computer capable of being communicatively coupled with the sales computer; and a memory capable of being communicatively coupled with the sales computer, including a plurality of digital content items, wherein each one of the plurality of digital content items is associated with a base price and at least one item configuration option associated with an option price, and wherein one of the plurality of digital content items is associated with the final price related to the base price and the option price by a final pricing formula.. (Application, Independent claim 8; FIG. 1; pg. 3, lines 14 - pg. 7, line 25).

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-5 and 7-11 stand rejected under 35 USC § 102(c) as being anticipated by Cansler (U.S. 6,725,257 B1; hereinafter “Cansler”).

7. ARGUMENT

A) The Applicable Law

It is respectfully noted that anticipation under 35 USC § 102 requires the disclosure in a single prior art reference of each element of the claim under consideration. *See Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim*.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). “The *identical invention* must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131 (emphasis added).

In addition, the interpretation of claim terms during examination must be tempered by the context in which the terms are used. The *Hyatt* court stated that “during examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification.” *In re Hyatt*, 211 F.3d 1367, 1372, 54 U.S.P.Q.2D (BNA) 1664, 1667 (Fed. Cir. 2000) (emphasis added) (“During examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification.”; citing *In re Graves*, 69 F.3d 1147, 1152, 36 U.S.P.Q.2D (BNA) 1697, 1701 (Fed. Cir. 1995); *In re Etter*, 756 F.2d 852, 858, 225 U.S.P.Q. (BNA) 1, 5 (Fed. Cir. 1985) (en banc)).

B) The Cited Reference

Cansler is directed to using a network to configure vehicle using compatible options. *See Cansler*, Col. 3, lines 41-65. The configuration process can be coupled with procuring a vehicle or “products other than vehicles” that are to be purchased “from a dealer, vehicle broker, or manufacturer ...”. *See Cansler*, Col. 4, lines 27-29. Cansler

also describes a product database 46 that stores “raw information about every base configuration” and a configuration database 48 that “stores the standards and option pages generated for each base configuration. See Cansler, FIG. 2 and Col. 5, lines 34-38.

C) Discussion of the rejection of claims 1-5 and 7-11.

The Appellant believes there is a clear deficiency in the *prima facie* case in support of the rejection. That is, the Appellant asserts that the Office has not shown that Cansler discloses the identical invention as claimed.

In the Office Action, it is asserted that Cansler “teaches a digital content pricing system, comprising ... a memory ... including a plurality of digital content items ...” as claimed by the Appellant. A careful reading of Cansler reveals that this assertion is incorrect – Cansler does not teach the use of digital content items that can, for example, be stored in a memory and sold directly to a consumer.

More specifically, the assertion that Cansler “teaches a digital content pricing system” is incorrect because Cansler is directed to describing and pricing a vehicle configuration. See Cansler, Col. 3, lines 41-44. A vehicle or “products other than vehicles” that are to be purchased “from a dealer, vehicle broker, or manufacturer” (see Cansler, Col. 4, lines 27-29) are not the same as the claimed digital content items.

The assertion that Cansler “teaches a memory ... including a plurality of digital content items” is incorrect for similar reasons. Cansler’s memory does not include “a plurality of digital content items,” which comprise the products themselves, as claimed by the Appellant. Instead, Cansler merely describes using databases 46, 48 having *information about the products*. See Cansler, FIG. 2.

While the Office maintains that “digital content” has been given very little patentable weight, this is not the same as no patentable weight. The Appellant respectfully notes that the term “digital content” is not used only in the preamble of the claim, but also in the claim body. It is not a phrase that merely indicates an intended use, as alleged by the Office, but rather comprises an object that can be stored in a memory, perhaps along with pricing meta-data, and delivered directly to a purchaser over a network. This type of operation is not possible using the teachings of Cansler. Thus,

while the Office asserts that digital content “and associated linked data is considered to be non-functional descriptive material, which does not patentably distinguish the applicant’s invention from Cansler”, this assertion fails to account for the difference between digital content and physical objects that can’t be stored in a memory.

Claims during examination should be interpreted as broadly as their terms reasonably allow. However, as noted by the *Hyatt* court, that interpretation must be at once reasonable, and consistent with the specification.

The interpretation of “digital content” proffered by the Office is neither reasonable, nor consistent with the specification. It is not reasonable because one of skill in the art would understand that digital content comprises a product that can itself be stored in a memory, manipulated and altered while stored therein, and subsequently delivered to a purchaser. One of skill in the art would therefore not understand the vehicle described by Cansler to constitute “digital content.”

The interpretation by the Office is also not consistent with the specification in the Application, which notes that digital content includes “on-line novels, software program packages, compact disks, electronic music albums, electronic magazines, movie packages (e.g., similar to or identical to the program content stored on a digital video disk), electronic news services, and similar items” that can be delivered directly to the purchaser over a network. Application, pg. 3, lines 22-25.

Since Cansler does not teach the identical invention claimed, independent claims 1 and 8 (as well as all claims depending from them) should be in condition for allowance. Reconsideration and withdrawal of the rejection of claims 1-5 and 7-11 under § 102(e) is therefore respectfully requested.

8. SUMMARY

For the reasons presented above, the Appellant submits that the rejection of claims 1-5 and 7-11 under 35 USC § 102(c) is improper. Therefore, reversal of the rejection and allowance of the pending claims is requested. The Examiner is invited to telephone the Appellant's attorney, Mark Muller, at (210) 308-5677 to facilitate prosecution of this Application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CLAIMS APPENDIX

1. (Rejected) A digital content pricing apparatus, comprising:
a sales computer to calculate a final price; and
a memory capable of being communicatively coupled with the sales computer, including a plurality of digital content items, wherein each one of the plurality of digital content items is associated with a base price and includes at least one item configuration option associated with an option price, and wherein one of the plurality of digital content items is associated with the final price related to the base price and the option price by a final pricing formula.
2. (Rejected) The digital content pricing apparatus of claim 1, wherein at least one of the plurality of digital content items is directly associated with the final pricing formula.
3. (Rejected) The digital content pricing apparatus of claim 1, wherein the memory includes a plurality of pricing formulae including the final pricing formula.
4. (Rejected) The digital content pricing apparatus of claim 1, wherein at least one of the plurality of digital content items is associated with a plurality of configuration options, including the item configuration option.
5. (Rejected) The digital content pricing apparatus of claim 1, wherein the final pricing formula includes an option adjustment factor associated with the item configuration option.

6. (Withdrawn) The digital content pricing apparatus of claim 1, wherein the final pricing formula includes a non-option specific adjustment factor associated with at least one selected external factor.
7. (Rejected) The digital content pricing apparatus of claim 6, wherein the at least one selected external factor is determined by a type of selected ones of the plurality of digital content items, a quantity of each type of the selected ones of the plurality of digital content items, the base price, and the option price.
8. (Rejected) A digital content pricing system, comprising:
a sales computer to calculate a final price;
a purchase computer capable of being communicatively coupled with the sales computer; and
a memory capable of being communicatively coupled with the sales computer, including a plurality of digital content items, wherein each one of the plurality of digital content items is associated with a base price and at least one item configuration option associated with an option price, and wherein one of the plurality of digital content items is associated with the final price related to the base price and the option price by a final pricing formula.
9. (Rejected) The digital content pricing system of claim 8, further comprising:
an item selection device capable of being communicatively coupled to the purchase computer.
10. (Rejected) The digital content pricing system of claim 9, wherein at least one of the plurality of digital content items is directly associated with the final pricing formula.
11. (Rejected) The digital content pricing system of claim 10, wherein the final pricing formula includes an option adjustment factor associated with the item configuration option.

12. (Withdrawn) A method of pricing digital content, comprising:
selecting a digital content item associated with a base price;
selecting at least one configuration option associated with the digital content item,
wherein the at least one configuration option is associated with an option price; and
calculating a final price associated with the digital content item, wherein the final price is related to the base price and the option price by a final pricing formula.
13. (Withdrawn) The method of claim 12, further comprising:
selecting an option adjustment factor associated with the item configuration option; and
modifying the final pricing formula to include the option adjustment factor.
14. (Withdrawn) The method of claim 12, further comprising:
selecting a formula adjustment factor associated with at least one external factor;
and
modifying the final pricing formula to include the formula adjustment factor.
15. (Withdrawn) The method of claim 14, comprising:
selecting a plurality of other digital content items associated with at least one other base price; and
selecting at least one other configuration option associated with the plurality of other digital content items, wherein the at least one other configuration option is associated with at least one other option price, and wherein the at least one external factor is determined by a number of selected ones of the plurality of other digital content items, a quantity of each one of the selected ones of the plurality of other digital content items, the at least one other base price, and the at least one other option price.
16. (Withdrawn) The method of claim 12, further comprising:

specifying pricing information for a plurality of options associated with the digital content using a corresponding plurality of meta-data descriptors.

17. (Withdrawn) The method of claim 16, further comprising:

specifying a final pricing formula in a meta-data descriptor associated with the digital content.

18. (Withdrawn) A method of pricing a digital content product package, comprising:

receiving an item selection associated with a prospective purchase;
presenting a plurality of product options associated with the item;
receiving an indication of at least one option chosen from the plurality of product options;

calculating an item price related to the item selection and the indication of at least one option chosen, wherein the item price is defined using a meta-data descriptor included in the digital content package; and

calculating a final product price related to the item price.

19. (Withdrawn) The method of claim 18, wherein the item price is related to an option price associated with the indication of at least one option chosen, and wherein the option price is defined using a meta-data descriptor included in the digital content package.

20. (Withdrawn) The method of claim 18, further comprising:

verifying a payment associated with the final product price.

21. (Withdrawn) An article comprising a machine-accessible medium having associated data, wherein the data, when accessed, results in a machine performing:

selecting a digital content item associated with a base price;

selecting at least one configuration option associated with the digital content item, wherein the at least one configuration option is associated with an option price; and

calculating a final price associated with the digital content item, wherein the final price is related to the base price and the option price by a final pricing formula.

22. (Withdrawn) The article of claim 21, wherein the machine-accessible medium further includes data, which when accessed by the machine, results in the machine performing:

recording the at least one configuration option.

23. (Withdrawn) The article of claim 21, wherein the machine-accessible medium further includes data, which when accessed by the machine, results in the machine performing:

selecting an option adjustment factor associated with the item configuration option; and

modifying the final pricing formula to include the option adjustment factor.

24. (Withdrawn) The article of claim 21, wherein the machine-accessible medium further includes data, which when accessed by the machine, results in the machine performing:

selecting a non-item specific adjustment factor associated with the digital content item; and

modifying the final pricing formula to include the non-item specific adjustment factor.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.